



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,391	08/06/1999	DANIEL H. ABELOW	03058/004002	6732

26161 7590 05/06/2004

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

DIXON, THOMAS A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/369,391

Applicant(s)

ABELOW, DANIEL H.

Examiner

Thomas A. Dixon

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72,90-96 and 102-104, 117 is/are pending in the application.
- 4a) Of the above claim(s) 1-71,73-89,97-101 and 105-116 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 72, 90-96, 102-104, 117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 36.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All the previously rejected claims have been cancelled. Claims 72, 90-96, 102-104, 117 that were indicated allowable remain. Careful review of the claim language necessitated the rejections below.
2. The IDS filed 6/30/2003 has been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 72, 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, in claim 72, it is unclear what processing is performed on the value information sent to the server for storage, therefore, it is seen as non-functional descriptive material and will not be treated on the merits. Further, it is unclear what linkage exists between the commodity and the device, which makes it unclear how the "event based on the user's interaction with the commodity" causes a response to the device from the server or what relationship "in the course of the user's interaction with the commodity" has to the device.

Specifically in claim 90, it is unclear how a device can be software, as a device or apparatus is by its nature hardware, as can be seen in claim 92 in which the device stores a script, such storage would imply a memory, which is hardware.

3. Claim 102 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, it is unclear how the software is executed since no means is clearly recited. Further, it is unclear if the trigger is being monitored at the server or the client.

4. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 102, including a server storing information and a client that receives information are disclosed in the Orr reference as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 72, 90-94 are rejected under 35 U.S.C. 102(a) as being anticipated by Orr (Join the Information Economy).

As per Claim 72.
Orr discloses:
the user records value information on a client device, see abstract, lines 9-11 and text, lines 17-20;
the client device sends the information to the server, see abstract, lines 9-13;
the client device receives from the server additional value information recorded by other users, in response to an event based on the user's interaction with the commodity, see text lines 17-24;
the client device presents the additional information to the user, see text lines 17-24.

As per Claim 90.
Orr further discloses, the device comprises software, see abstract, lines 14-15, and text line 21.

As per Claim 92.
Orr further discloses, the device stores a script for probing a user for value information, see abstract, lines 9-11, and text lines 19-20.

As per Claim 93.
Orr further discloses, the device receives a script from the server, see abstract, lines 9-11, and text lines 19-20.

As per Claim 94.
Orr further discloses, the value information guides the users interaction with the commodity, see text line 19 and page 2, lines 4-11.

As per Claim 95.
Orr further discloses, the event is a user request, see text lines 17-21.

As per Claim 103.
Orr further discloses the information received by the client device comprises navigational pointers, see text, line 19.

As per Claim 104.
Orr further discloses the information received by the client device comprises hypertext, see text, line 19.

6. Claim 102 is rejected under 35 U.S.C. 102(a) as being anticipated by Orr.

Art Unit: 3629

6. Claim 102 is rejected under 35 U.S.C. 102(a) as being anticipated by Dyson (Information, bid and Asked), Orr (Join the Information Economy), or Fryxell (Driving a hard bargain).

As per Claim 102.

Dyson (Information, bid and Asked), Orr (Join the Information Economy), and Fryxell (Driving a hard bargain) disclose:

a server storing information and clients receiving information, see abstracts of Dyson and Orr and paragraphs 3-4 of Fryxell.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 91, 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orr in view of Young (4,695,707).

As per Claim 91.

Orr does not specifically disclose the device is part of the commodity.

Young ('707) teaches the device is part of the commodity, see column 4, lines 4-42 and column 6, lines 66-68 for the benefit of ending a monitoring cycle when a fault occurs.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to monitor a process and force premature termination as taught by Young ('707) for the benefit of ending a monitoring cycle when a fault occurs.

As per Claim 96.

Orr does not specifically disclose the event is an exception resulting from the use of the commodity.

Young ('707) teaches monitoring a process and force premature termination, see column 4, lines 4-42 and column 6, lines 66-68 for the benefit of ending a monitoring cycle when a fault occurs.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to monitor a process and force premature termination as taught by Young ('707) for the benefit of ending a monitoring cycle when a fault occurs.

8. Claim 117 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dyson (Information, bid and Asked), Orr (Join the Information Economy), and Fryxell (Driving a hard bargain) disclose in view of Young (4,695,707).

As per Claim 117.

Orr does not specifically disclose the passive evaluation.

Young ('707) teaches the passive evaluation, see column 4, lines 4 -42 and column 6, lines 66-68 for the benefit of ending a monitoring cycle when a fault occurs.

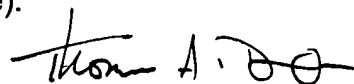
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to passively monitor a process as taught by Young ('707) for the benefit of ending a monitoring cycle when a fault occurs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner